

REMARKS

Reconsideration and withdrawal of the requirements for restriction and election of species are respectfully requested in view of the remarks herewith, which place the application in condition for allowance.

The January 15, 2002 Office Action required restriction under 35 U.S.C. § 121 to one of the following:

Group I: Claims 5 and 9, drawn to a method of regulating transcription comprising introducing into a plant cell an engineered zinc finger polypeptide fused to a transcriptional activator domain, classified in class 435, subclass 469;

Group II: Claims 6 and 9, drawn to a method of regulating transcription comprising introducing into a plant cell an engineered zinc finger polypeptide fused to a transcriptional repressor domain, classified in class 435, subclass 470;

Group III: Claims 7 and 8, drawn to a plant host cell and transgenic plant comprising a polynucleotide encoding an engineered zinc finger polypeptide, classified in class 435, subclass 419.

The Examiner states that claims 1-4 link the claims of Groups I-III, such that upon allowance of the linking claims, the restriction requirement will be withdrawn, and any claims depending from, or otherwise including all the limitations of the allowable linking claims will then be entitled to examination in the instant application.

Applicants acknowledge the Examiner's statement, and elect the claims of Group III, with traverse.

The present invention relates to, *inter alia*, regulating transcription in a plant cell from a DNA sequence comprising a target DNA operably linked to a coding sequence, wherein an engineered zinc finger polypeptide is introduced into a plant cell.

Under 35 U.S.C. §121, “two or more independent and distinct inventions ... in one application may... be restricted to one of the inventions.” Inventions are “independent ” if there is no distinct relationship between two or more subjects disclosed (MPEP 802.01). The term “distinct ” means that “two or more subjects as disclosed are related ... but are capable of separate manufacture, use or sale as claimed, *and are patentable* (novel and unobvious) *over each other*” (MPEP 802.01, July 1988) (emphasis is original). However, even with patentably distinct inventions, restriction is NOT required unless one of the following reasons appears (MPEP 808.02) (emphasis is original):

Separate classification;
Separate status in the art; or
Different field of search.

Under Patent Office examining procedures, “[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions” (MPEP 803) (emphasis added).

Further, pursuant to 37 C.F.R. §1.141(b), “the process of using [a claimed product] may be joined with the claims directed to the product and the process of making the product even though a showing of distinctiveness between the product and the process of using the product can be made.”

It is respectfully submitted that the Groups designated by the Examiner fail to meet the criteria warranting separate examination and search. The present claims represent a web of knowledge and continuity of effort that merits examination in a single application.

The claims of Groups I, II and III involve regulating transcription in plants through an engineered zinc finger polypeptide, thereby encompassing the same field of search. More specifically, the claims of Groups I, II and III are related since the claims in all three groups are classified in class 435. The Office Action maintains that the claims of Groups I, II and III are unrelated, and references MPEP §§806.04 and 808.01 in stating “inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions or different effects” (Office Action at 3). The Office Action states that in this instance “the different inventions have different modes of operation or different effects” (*Id.*). It is respectfully submitted that under the guidelines set forth in MPEP

§§806.04 and 808.01, for inventions to be considered unrelated, they must not be disclosed as capable of use together, AND one of the following must be true: the inventions have different modes of operation or have different effects. In the instant case, the claims of Groups I, II and III ARE capable of use together, which renders the question of whether they have different modes of operation or different effects moot. By simply being capable of use together, the inventions are related, and as such, should be searched and examined together.

In addition, it is respectfully submitted that the Office Action has not set forth evidence that examination of Groups I, II and III would constitute a serious burden on the Examiner. Again, the claims of Groups I, II and III are all classified within class 435, which not only shows that the search would not, in fact, constitute an undue burden, but that the claims are related as shown by their classification.

In summary, enforcing the present restriction requirement would result in inefficiencies and unnecessary expenditures by both the Applicants and the PTO, as well as extreme prejudice to Applicants (particularly in view of GATT, a shortened patent term may result in any divisional applications filed). Restriction has not been shown to be proper, especially since the requisite showing of serious burden has not been made in the Office Action and there are relationships between the claims of Groups I, II, and III. Indeed, the search and examination of each Group is likely to be co-extensive and, in any event, would involve such interrelated art that the search and examination of the entire application can be made without undue burden on the Examiner. All of the preceding, therefore, mitigates against restriction.

Consequently, reconsideration and withdrawal of the restriction requirement is respectfully requested.

CONCLUSION

Accordingly, in view of the foregoing, reconsideration and withdrawal of the restriction and election of species requirements are requested, and an early and favorable examination on the merits is earnestly solicited.

Respectfully submitted,
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